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09/736,036	12/13/2000	Roger P. Hoffman	P/2-79	6629

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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Commissioner for Patents

CUONG H. NGUYEN
Primary Examiner
Art Unit: 3625

Office Action Summary

Application No.

09/736,036

Applicant(s)

HOFFMAN, ROGER P.

Examiner

CUONG H. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This Office Action is the answer to the communication received on 12/13/2000; which paper has been placed of record.
2. Claims 1-9 are pending in this application.

Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 112 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (**the provisional application must be disclosed in the first page of the specification**); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Drawings

4. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5A. Claims 8-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5B. Practical Application in the Technological Arts:

When an invention is reduced to a practical application in the technological arts, the invention is statutory. Therefore, the claimed invention must produce a "useful, concrete and tangible result" (the pending claims satisfy this requirement); **and** the claimed invention must utilize technology in a non-trivial manner (i.e., the claim **MUST** include a limitation in the technological arts that enables a useful, concrete, and tangible result.

5C. The phrase "technological arts" is synonymous with the phrase "useful arts" as it appears in Article I, Section 8 of the Constitution, In re **Waldbaum**, 173 USPQ 430 (CCPA 1972). For a claim to be statutory, it must be in the technological arts. In re **Musgrave**, 167 USPQ 280 (CCPA 1970) and In re Johnston, 183 USPQ 172 (CCPA 1974).

5D. The technological arts inquiry must focus on whether the claimed subject matter is statutory. In re **Toma**, 197 USPQ 852 (CCPA 1978). In that case, **Toma** held "that the method of enabling a computer to translate natural languages in the technological arts, i.e., claims 8-9 merely providing information".

5E. The invention as recited in those pending claims is merely an abstract idea that is not within the technological arts. Mere ideas that do not positively apply the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. In the body of claims 8-9 must recite technology that

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positively contributing to each claim's limitation. If the invention in the bodies of these claims are not tied to technological art, environment, or machine, the claim is not statutory. Ex parte **Bowman**, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), even though **Bowman** is not precedential, **Bowman** is being cited for its analysis of whether the claim is in the technological arts; also note MPEP 2106 IV 2(b). 5F. Merely nominal use of a computer system, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the computer does not affect or effect the underlying process.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Perkowski (US Pat. 5,950,173).

A. As to claim 1: Perkowski teaches a system for performing sales transactions online (see **Perkowski**, Fig. 3A2), comprising:

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- a database (see **P rkowski**, Figs. 1 & 2A1); said database containing of a profile of agents (see **Perkowski**, Fig. 3B, 7:34-36, 9:9-13); said database containing of information about each user (see **Perkowski**, 11:64-67 i.e., "User (or Client) Computers, each indicated by reference numeral 13, being connected to the Internet via the Internet infrastructure and available to consumers (C.sub.1, C.sub.2, C.sub.3, . . . ,C.sub.i)");
- said database being capable of communicating with said user in writing utilizing stored email addresses (see **Perkowski**, Fig. 4A1).

B. As to claim 7: **Perkowski** teaches a method for performing sales transactions online comprising:

- logging into a database (see **Perkowski**, 11:64-67 i.e., "User (or Client) Computers, each indicated by reference numeral 13, being connected to the Internet via the Internet infrastructure and available to consumers (C.sub.1, C.sub.2, C.sub.3, . . . ,C.sub.i)");
- entering information that can be identified by said database (see **Perkowski**, Figs. 3A2, 3b, 3c, 4A1, 4A2, 4B, 6A);
- selecting a virtual sales agent/kiosk provided by said database (see **Perkowski**, Fig. 3A2);
- providing information/query to said virtual sales agent/kiosk about a product (see **Perkowski**, Figs. 3A2, 3b, 3c, 4A1, 4A2, 4B, 6A).

C. As to claim 8: **Perkowski** teaches a method of performing a sales transaction online comprising:

- providing information to a user concerning the user's personal life (i.e., an email address, a telephone number, or a shipping address etc.);

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- providing information to said user concerning past business transactions (i.e., an email address, a telephone number, or a shipping address etc.);
- providing information to a user comprising price information for products for sale (see **Perkowski**, Figs. 3A2, 3b, 3c, 4A1, 4A2, 4B, 6A).
- Those are fundamental information that are stored on databases in doing business on the Internet – please see similar rationales from **Perkowski's** teaching for rejections in claims 1, and 7).
- D. As to claim 9: **Perkowski** teaches a method of performing a sales transaction wherein information is provided via e-mail (i.e. see **Perkowski**, 27:15-36, "In the illustrative embodiments of the present invention, the data-synchronized IPD Servers of the system hereof are also provided with an "Automated Registration Solicitation Mode" programmed by the webmaster (or administrator) of the IPI Web-site. In this mode, each IPD Server analyzes the data collected within its Non-IPI Registrant Database. The data analysis procedure seeks to determine: (1) which "unregistered" products in the Non-IPI Registrant Database were the subject of an information request at the IPD Server; (2) how many hits (requests) were made for the product within a predetermined length of time (e.g. one week) by Internet users; and (3) whether the number of requests exceeds a particular "request threshold" (e.g. 100 requests in week period). Then for each unregistered product which has exceeded the request threshold, the IPD Server automatically sends an E-mail message to the associated company. Preferably, the E-mail message is designed to (i) inform the company of recent information requests for their products, and (ii) solicit the registration of such products with the

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IPD Server. Once registered with the system, such products can be easy found on the Internet by anyone wishing to use the product information finding techniques of the present invention.") .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkowski as applied to claim 1 above, and further in view of the Official Notice.

The rationales and reference for rejection of claim 1 are incorporated.

The examiner submits that it is old and well-known to teach that:

A. As to claim 2: A transaction apparatus comprises a three dimensional representation (please note that 3-D representation on computer is old and well-known).

B. As to claim 3: A transaction apparatus comprises information about a user (e.g., information about a telephone number, and an address for business and personal communication).

C. As to claim 4: A transaction apparatus comprises a completed sales transaction (e.g., storing an e-commerce purchase transaction between a buyer and amazon.com).

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D. As to claim 5: A transaction apparatus comprises physical characteristics of said kiosk/(sales agent)(e.g., see **Perkowski**, US Pat. 6,625,581 "Within the store of each retailer subscribing to the UPC REQUES.TM. Consumer Information Service, the function of the UPC REQUESTm kiosk is to provide consumer access to the UPC REQUEST.TM. Retailer Website (e.g. UPC REQUEST.TM. Retail @Wal-Mart, UPC REQUEST.TM. Retail @Home Depot, etc.). The UPC REQUEST.TM. Retailer Website served to both physical-kiosk and cyber-kiosks within the retailer's brick and mortar and EC stores, respectively, provides consumer access to UPN/URL information links relating only to those products sold by the retailer and maintained within the UPC REQUES.TM. Database Management System by the manufacturer or agent thereof. If desired by the subscribing retailer, its UPC REQUEST.TM. Retailer Website can be freely served to customers over the Internet, e.g. accessible from a hot-link embedded somewhere in the retailer's Web-site.") .

E. As to claim 6: A transaction apparatus wherein a communication can be via e-mail(e.g., see **Perkowski**, US Pat. 6,625,581, "In one arrangement, each manufacturer-operated client machine 13 would be assigned the task of managing the UPN/URLs associated with a particular department of the manufacturer (e.g. engineering department, sales department, service/support department, marketing department, advertising department, etc.). The UPN/URLs menus and other CPI related information collected by each department is maintained within a local UPN/URL Database 202 on the department's client machine 13, and is periodically transmitted to a Manufacturer's UPN/URL Database 203 hosted on the network Internet server 133 In addition to providing the client machine behind the corporate firewall with http, e-mail and ftp services, the network Internet server 133 is also equipped with an EDI (e.g. EDI or

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XML/ICE) software solution which enables periodic uploading of the manufacturer's UPN/URL Database 203 to the Central UPN/URL Database Management Subsystem 9, shown in FIG. 2C

"In the illustrative embodiments of the present invention, the data-synchronized IPD Servers of the system hereof 11 are also provided with an **"Automated Registration Solicitation Mode"** programmed by the webmaster (or administrator) of the IPI Web-site(s). In this mode, each IPD Server II analyzes the data collected within its Non-IPI **Registrant Database**. The data analysis procedure seeks to determine: (1) which "unregistered" products in the Non-IPI Registrant Database were the subject of an information request at the IPD Server; (2) how many hits (requests) were made for the product within a predetermined length of time (e.g. one week) by Internet users; and (3) whether the number of requests exceeds a particular "request threshold" (e.g. 100 requests in week period). Then for each unregistered product which has exceeded the request threshold, the IPD Server automatically sends an E-mail message to the associated company. Preferably, the E-mail message is designed to (i) inform the company of recent information requests for their products, and (ii) solicit the registration of such products with the IPD Server. Once registered with the system, such products can be easy found on the Internet by anyone wishing to use the product information finding techniques of the present invention.").

It would have been obvious to one of ordinary skill in the art at the time of invention to implement Perkowski's teaching with above Official notices to suggest a transaction system having above claimed limitations; because artisans would recognize that a those information are easy to identified, and using an email in the Internet for communication is very convenient and are flexible.

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Conclusion

8. The attached prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 703-305-4553. The examiner can normally be reached on 7 am - 330 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VINCENT A. MILLIN can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

CHN
Cuong H. Nguyen

CUONG H. NGUYEN
Primary Examiner
Art Unit 3625